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Milton S. Sales  
Patent Legal Staff  
Eastman Kodak Company  
343 State Street  
Rochester, NY 14650-2201

EXAMINER

COULTER, KENNETH R

ART UNIT

PAPER NUMBER

2141

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/892,042

Applicant(s)

MCINTYRE, DALE F.

Examiner

Kenneth R. Coulter

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-21 is/are allowed.
- 6) ☒ Claim(s) 1,9 and 12-17 is/are rejected.
- 7) ☒ Claim(s) 2-8,10 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. The claimed invention (claims 12 – 17) is directed to non-statutory subject matter.

Independent claims 12 and 17 are directed to software that is not embodied on a **computer usable storage medium**.

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

***Claim Objections***

3. Claim 17 is objected to because of the following informalities:

“computer readable code **embodied said** computer useable medium” (claim 17, line 2 – 3)

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 9, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Niamir (U.S. Pub. No. 2002/0027567) (Listing Network for Classified Information).

- 5.1 Regarding claim 1, Niamir discloses a method for managing digital image media files comprising the steps of:

providing a server for managing access to a digital image media collection stored on a remote user computer of a user, said digital image media collection having at least

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one digital media file, said at least one digital media file having at least one image file of a predetermined resolution, said server capable of communicating over a communication network with said user computer, said user providing an initial authorization for managing of said digital images by said server (Abstract; Figs. 1, 2; paragraph 99); and

controlling automatic periodic access by said server to said image media collection in said user computer without any further authorization by said user (Abstract; Figs. 1, 2; paragraphs 53, 74).

5.2 Per claim 9, Niamir teaches a method according to claim 1 wherein instructions regarding providing of goods and/or services are provided automatically (paragraphs 33, 102 "goods or services").

5.3 Regarding claim 17, Niamir discloses a software product comprising a computer useable medium and computer readable code embodied **on** said computer usable medium which when loaded into a computer will cause said computer to perform the following step of:

allowing controlled access by a service provider over a communication network to a user media file stored on a user computer, said user media file having at least one digital image file (Abstract; Figs. 1, 2; paragraphs 53, 74, 99).

***Response to Arguments***

6. Applicant's arguments filed 1/19/06 have been fully considered but they are not persuasive.

Applicant states that in Niamir, the user does not provide an initial authorization for managing an image file by the server.

Examiner disagrees.

The Examiner points to the "authentication server 64" (paragraph 99; Fig. 1). "Users who are authenticated can then have their listings 30 synchronized with and saved at a CSS 16 from where they can be retrieved by other users of the system 10 for searching" (paragraph 99).

***Allowable Subject Matter***

7. Claims 18 – 21 are allowed.

8. Claims 2 – 8, 10, and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

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9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Anderson et al. U.S. Pat. No. 6,567,122 Method and System for Hosting an Internet Web Site on a Digital Camera

A digital camera that hosts a web site. Images that can be accessed by an ISP are stored on the digital camera (see Fig. 7).

Watanabe et al. U.S. Pat. No. 6,578,072 Network Photograph Service System

A network photograph service system with a low resolution image database (thumbnail images; located at the center server) for browsing and a high resolution image database (located at the laboratory server) for printing (see Fig. 2).

Wood et al. U.S. Pat. No. 6,732,162 Method of Providing Preprocessed Images for a Plurality of Internet Web Sites

A method of providing images to plural web sites, the web sites having different viewing requirements. The method mirrors the media object to multiple remote databases.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R. Coulter whose telephone number is 571 272-3879. The examiner can normally be reached on 5 4 9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KENNETH R. COULTER  


krc